

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 3, and 4 are presently active in this case, Claims 1 and 4 having been amended and Claims 2 and 5-14 having been canceled without prejudice or disclaimer by way of the present Amendment. Care has been taken such that no new matter has been entered. (See, e.g., paragraph [0075] and Figures 6 and 7.)

In the outstanding Official Action, Claims 1, 2, 4-6, 8-10, and 12-14 were rejected under 35 U.S.C. 102(b) as being anticipated by Matsumoto et al. (U.S. Patent No. 5,802,443). Claims 1, 3, 5-7, and 9-11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Curry et al. (U.S. Patent No. 6,119,969) in view of paragraphs [0004] and [0005] of the present application. For the reasons discussed below, the Applicants request the withdrawal of the rejections.

In the Office Action, the Matsumoto et al. reference is indicated as anticipating each of Claims 1, 2, 4-6, 8-10, and 12-14. However, the Applicants note that a claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As will be demonstrated below, the Matsumoto et al. reference clearly does not meet each and every limitation of the independent Claim 1.

Claim 1 recites a method of producing a heating roller, comprising: drawing a core of hollow cylinder form by engaging an outer circumference surface of the hollow cylinder form with a ring-shaped member, moving the ring-shaped member and the hollow cylinder form

relative to one another in a longitudinal direction of the hollow cylinder form, and changing a diameter of the ring-shaped member during the relative movement; and cutting an outer circumference surface of the core, wherein a thickness of the core is greater in a center portion thereof than in end portions thereof, and wherein in the drawing step, the core is drawn such that an inside diameter of the core is smaller in the center portion thereof than in the both end portions thereof. The Matsumoto et al. reference clearly does not disclose all of the above limitations.

The Matsumoto et al. reference is cited for the teaching of the configuration depicted in Figure 29. The Applicants note that the Matsumoto et al. reference also describes and depicts numerous embodiments that include inner supporting or reinforcing members that are positioned within the roller. For example, Figure 12 depicts an embodiment in which supporting member (46) is positioned within a thin cylindrical structure (45). The Matsumoto et al. reference then describes that the cylindrical structure is plastically worked so that the outside diameter is reduced, thereby fixing the supporting member within the cylindrical structure.

However, the Applicants note that the Matsumoto et al. reference does not disclose drawing a core of hollow cylinder form by engaging an outer circumference surface of the hollow cylinder form with a ring-shaped member, as recited in Claim 1 of the present application. Thus, the Matsumoto et al. reference also does not disclose moving the ring-shaped member and the hollow cylinder form relative to one another in a longitudinal direction of the hollow cylinder form, and changing a diameter of the ring-shaped member during the relative movement. No such ring-shaped member is disclosed or suggested by the

Matsumoto et al. reference, and certainly no ring-shaped member that changes diameter during relative movement between the ring-shaped member and the hollow cylinder form.

Accordingly, the Matsumoto et al. reference fails to disclose all of the limitations expressly recited in the independent claim of the present application. Thus, the Matsumoto et al. reference fails to anticipate independent Claim 1 of the present application. Therefore, the Applicants respectfully request the withdrawal of the anticipation rejection of Claim 1 and the claims that depend therefrom.

Regarding the obviousness rejection of Claim 1, the basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations. The Applicants submit that a *prima facie* case of obviousness cannot be established in the present case because the cited references, either when taken singularly or in combination, do not teach or suggest all of the claim limitations.

The Official Action notes that the Curry et al. reference does not disclose how the roller is formed, or the specific steps of drawing the core to form the roller. The Official Action cites pages 1-2 of the present application for such a teaching. The Applicants note that pages 1-2 of the present application do not disclose or even suggest drawing a core of hollow cylinder form by engaging an outer circumference surface of the hollow cylinder form with a ring-shaped member, moving the ring-shaped member and the hollow cylinder form relative to one another in a longitudinal direction of the hollow cylinder form, and changing a

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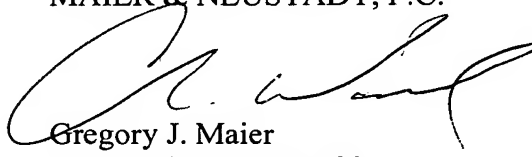
diameter of the ring-shaped member during the relative movement, as recited in Claim 1 of the present application. Accordingly, pages 1-2 of the present application do not supplement the deficiencies in the teachings of the Curry et al. reference discussed above.

Thus, the Applicants submit that a *prima facie* case of obviousness cannot be established with respect to Claim 1 based on the cited references. Therefore, the Applicants respectfully request the withdrawal of the obviousness rejection of Claim 1 and the claims that depend therefrom.

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

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